REMARKS

Claims 1-53 and 55-62 are pending in the application.

Claims 1-18, 24-26, and 46-50 stand rejected.

Claims 19-23, 27-45 and 51-62 have no rejections.

I. FULL FAITH AND CREDIT

In the Decision on Appeal, the Board has issued a new grounds of rejection, rejecting claims 1-7, 9-16 and 18 under 35 U.S.C. § 102(e) as being anticipated by *Pool* (U.S. Patent 6,460,020). Applicants respectfully assert that this is in violation of MPEP § 706.04. In that Section, it states that "Full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art." Many of these same claims, particularly the independent claims, have already been previously rejected under 35 U.S.C. § 102(e) as being anticipated by *Pool* in the Office Action having a mailing date of May 8, 2003. Applicants successfully traversed these rejections. In fact, that is why the Examiner resorted to combining *Pool* with the *Kroenke* reference. This "new grounds of rejection" provides no new arguments relative to the previous § 102 rejection based on *Pool*, and does not point out any clear error in that previous rejection. Applicants are dismayed that they now have to again address a rejection they previously traversed.

II. REJECTIONS UNDER 35 U.S.C. § 102

The Board has rejected claims 1-7, 9-16 and 18 under 35 U.S.C. § 102(e) as being anticipated by *Pool*. In response, Applicants respectfully traverse. Applicants incorporate by reference their previous arguments over the § 102 rejections of the claims based on *Pool*, including those arguments issued by Applicants in their Amendment under 37 C.F.R. § 1.111 on February 7, 2003.

As the Patent Office is well aware, for a § 102 rejection to be valid, each and every limitation must be found within the cited prior art reference. Such limitations may not be implied or inferred.

In rejecting the claims, the Board has made several Findings of Fact. On page 15 of the Decision on Appeal, the Board makes the following assertions:

> Pool describes "transferring" the product identifier to a server hosting a database of product identifiers and tariff classification information particular to the product identifiers (See finding of Fact 11). Pools' [sic] third database has a look-up table for finding the commodity code for the selected product. This requires that the product identifier be transferred as claimed or else the look-up process would be inoperative.

The Board's assertion of what is taught in *Pool* is erroneous. Nowhere in the Finding of Fact 11, or column 6, line 51 – column 7, line 5 of *Pool*, is it disclosed that a product identifier, or any other data, is transferred to the third database. *Pool* does a terrible job of describing the process in which the third database is utilized. Applicants assert that the Patent Office may not infer or imply what is taught if the Patent Office is going to issue a § 102 rejection. In contrast, it is even more plausible that *Pool* teaches that the webpage containing the third database is sent for viewing by the customer, who manually performs a look-up of the commodity code. In no way does *Pool* describe or even imply that a product identifier is transferred to the third database.

Essentially, the Patent Office has trivialized the process of designating tariff classification information for a product to be imported/exported by asserting that *Pool* describes such a process with its "online shopping" invention. Tariff classification is taken very serious by U.S. federal government and other countries. This is evident by the attached document issued by the U.S. Department of Homeland Security on compliance and reasonable care as viewed by U.S. Customs and Border Protection. The present invention is designed to meet such compliance and reasonable care requirements. *Pool* does not.

Moreover, the system in *Pool* is not necessarily inoperative if such a product identifier is not transferred for the look-up process. Clearly, the *Pool* reference is operative if a customer is permitted to manually review a database showing commodity codes with tariff classification

information in a table that the customer can view and then determine the commodity code, which the customer can then use for their own information, or use for other transactions within the system described in *Pool*. See column 6, line 67 – column 7, line 5.

Furthermore, as Applicants have previously argued before the Patent Office, the commodity codes pertain to product types – not a particular product within a type. This has even been affirmed by the Board on page 7 of the Decision on Appeal. The present invention uses a database of product identifiers and tariff classification information particular to each of the product identifiers in order to permit a user to find tariff classification information for a particular product for subsequent use in an import/export transaction. *Pool* does not teach such a process. Instead, a look-up table is at most used manually by a customer viewing the look-up table over the internet to determine the commodity code for a product they wish to purchase. This is not the same as what is recited within the claims, and Applicants have more than adequately argued these points previously in the prosecution of this Application.

The Board has further asserted that the matching step is inherent in the operation of the look-up table in *Pool*. This is also erroneous. As noted above, the third database in *Pool* is used to arrive at a commodity code based on a product type. This is not the same as the matching step recited within the claims. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP § 2112. In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art. *Id.* The step of matching the product identifier identifying the product to the product identifiers in the database, which is a database of product identifiers and tariff classification information particular to each of the product identifiers, has not been shown by the Board to necessarily flow from the teachings of *Pool*. Merely that such a matching process may occur in *Pool* is not sufficient to establish the inherency of this limitation.

Next, the Board asserts that *Pool* describes the outputting step, but is not clear in how *Pool* teaches that the data record that is outputted includes tariff classification information associated with a product identifier identifying the product. The Board admits that what is

outputted from the third database is a commodity code. Further, the Board has already admitted that a commodity code is not the same as a product identifier. The Board then goes on to attempt to fill in this hole in its argument by asserting that *Pool* teaches that the data record may include additional information; and, then it is assumed that the Board is asserting that such additional information would include tariff classification information associated with the product identifier identifying the product. The problem is that assumptions cannot be made under a § 102 rejection. *Pool* does not teach, nor does it suggest, outputting a data record that includes a tariff classification information associated with the product identifier identifying the product.

Claim 9 recites the recording of results of the matching step into a transaction database hosted by the server. The Board has asserted that claim 9 is silent as to the particular results to be recorded. This is incorrect. The matching step of claim 1 results in a data record that is output wherein the data record includes tariff classification information associated with the product identifier identifying the product. *Pool* does not teach or disclose recording results of the matching step into a transaction database. In fact, as Applicants asserted above, it is more likely that *Pool* merely provides the third database for a customer to manually look up a commodity code. Therefore, there would be no need in *Pool* to record the results of any kind of matching step with respect to the third database.

With respect to the means plus function claims 10-16 and 18, the Board has asserted that *Pool* teaches a general purpose computer system, and that Applicants have failed to point out any specific structure beyond such a general purpose computer system. This is erroneous. In the Reply Brief, Applicants pointed out how the general purpose computer system is structured to perform the specific task within the means plus functions claims. It is well known that a general purpose computer system specifically configured to perform recited functions in a claim is patentable. As noted above, there are specific functions recited within the claims that are not taught or suggested within *Pool*. Therefore, the means plus function claim recitations are also not taught or suggested by *Pool*.

III. REJECTION UNDER 35 U.S.C. § 103

Claims 8 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Pool*. Applicants respectfully traverse. With respect to these claims, the Board has asserted that *Pool* describes the maintaining of the fourth database in Findings of Fact 14 and 17. The fourth database is not performing the functions of the third database, which has been specifically cited by the Board as the database that allegedly teaches the database recited in the claims from which 8 and 17 depend. However, claims 8 and 17 recite updating the database of those independent claims. Therefore, for *Pool* to teach or suggest the updating of the database recited within the claims, *Pool* would have to teach or suggest the updating of the third database. This is not what the Board has asserted.

IV. REJECTIONS UNDER 35 U.S.C. § 101

Though Applicants disagree with the Board's rejection of the claims, asserting that the language "computer program product for storage on a computer readable medium" is not statutory, Applicants have amended these claims as suggested by the Board.

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Respectfully submitted,

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